

### REMARKS

This responds to the Office Action mailed on September 1, 2005, and the references cited therewith.

Claims 1, 18, and 35 have been amended to correct a typographical error. Accordingly, no new matter has been added.

#### §103 Rejection of the Claims

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Conklin et al. (U.S. 6,141,653, hereinafter "Conklin") in view of Horn et al. (U.S. Publication No. 2001/0037204 A1, hereinafter "Horn").

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that the Office Action does not make out a *prima facie* case of obviousness for at least the reason that prior art fails teach or suggest every element of each of the independent claims, as contended in the Office Action (OA).

As conceded to by the Office Action (Pg. 2), Conklin does not disclose, "automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement," as recited in claim 1.

Applicant respectfully disagrees with the Examiner's characterization of Horn to provide the elements missing from Conklin. Horn discusses an online dispute resolution system that allows involved parties to negotiate a settlement with respect to their dispute. The Office Action specifically states Horn discloses the recited limitation of claim 1 in, "the system is designed to minimize overhead costs by automatically reminding the parties of a pending settlement offer." (paragraph 0017) However, what is clearly missing at the very least from this quote, Horn as a whole, and Conklin, is the claim 1 limitation, "presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement." (emphasis added) In addition, although Conklin discusses a network negotiation system and Horn a settlement offer, neither Conklin nor Horn implicitly or explicitly discusses a compliance obligation imposed under a commerce transaction agreement by a second party, as recited in claim 1. Because adding what is taught in Horn to Conklin fails to disclose each and every element of the independent claims, these claims are patentable over the cited art.

Therefore, for at least these reasons, claim 1 and all claims dependent therefrom are patentable over Conklin in view of Horn. The same arguments that applied to claim 1 are also applicable to independent claims 18 and 35, and their associated dependent claims.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4045 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

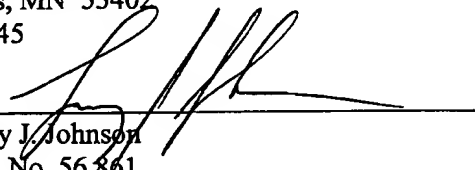
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By his Representatives,

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Date December 1, 2005

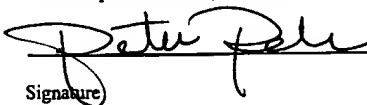
By

  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1 day of December, 2005.

Peter Rabuffoni

Name

  
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